Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. PATTON and GUSTAVO R. PAZ-PUJALT

Appeal No. 2004-1610
Application No. 09/359,152[1]

ON BRIEF

Before HAIRSTON, LEVY, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-5, which are all of the claims pending in this application. Claims 6-14 have been canceled.

We reverse.

BACKGROUND

Appellants' invention is directed to electronically transmitting a digital image to a receiving agency and providing

[1] Application for patent filed July 22, 1999.

authorization for the image to be printed, such as on a postage stamp. According to Appellants, the receiving agency examines the transmitted digital image to determine whether it is acceptable in order to avoid images that might be offensive in nature (specification, pages 2 & 3).

Representative independent claim 1 is reproduced as follows:

> 1. A method of authorizing the making of postage stamp images on a receiver by a receiving agency comprising the steps of:
>
> (a) electronically transmitting a digital image file over a channel to the receiving agency;
>
> (b) the digital image file includes at least one digital image and authorization information for making postage stamp images on a receiver; and
>
> (c) receiving the digital image file at the receiving agency, displaying at least one received digital image and examining the displayed digital image to determine whether its contents are acceptable for making postage stamp images and examining the authorization information and printing at a designated location that accepts digital images on a receiver corresponding to the transmitted digital image when the authorization information is approved.

The Examiner relies on the following prior art reference:

Enomoto et al. (Enomoto)	5,974,401	Oct. 26, 1999 (filed Sep. 3, 1997)

Claims 1-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Enomoto.

We make reference to the final Office action (Paper No. 7, mailed February 26, 2003) and the answer (Paper No. 10, mailed

February 10, 2004) for the Examiner's complete reasoning, and to the appeal brief (Paper No. 9, filed November 14, 2003) for Appellants' arguments thereagainst.

OPINION

The focus of Appellants' arguments is that the manual quality adjustment in Enomoto does not correspond to evaluating whether the image content is offensive or not (brief, page 4). Appellants further point to the image correction taught by Enomoto and argue that the reference calls for adjusting or enhancing the setting of the image appearance (col. 7, lines 32-38) such as color balance, instead of examining its content (id.). The Examiner responds by characterizing the fact that the operator in Enomoto views the image on a display for making corrections (col. 8, lines 60-65), as inherently teaching that the content of the image is checked for acceptability (answer, page 3).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947

(Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

After a review of Enomoto, we agree with Appellants that the manual corrections by the operator in Enomoto do not represent the claimed examining the image to determine whether its content is acceptable. What a reference teaches is a question of fact. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (citing In re Beattie, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992)). Here the Examiner ignores the fact that the claimed examining the image for its content is not the same as reviewing the image by an operator for enhancing or correcting the appearance of the image. Additionally, contrary to the Examiner's assertion (answer, page 3) that the operator in Enomoto can also inherently check the images for offensive content, the reference contains no factual evidence that would reasonably establish this assertion. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." Continental Can Co. V. Monsanto Co., 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Therefore, as pointed out by Appellants (brief, the paragraph bridging pages 4 and 5), the Examiner's findings and

reasoning do not satisfy this requirement and are insufficient to support a prima facie case of anticipation. Accordingly, the rejection of claims 1-5 under 35 U.S.C. § 102 over Enomoto cannot be sustained.[2]

[2] Our decision not to sustain the 35 U.S.C. § 102 rejection of claims 1-5 should not be construed as meaning that we consider the claims on appeal to be patentable over Enomoto. In fact, the Examiner is advised to consider the possibility of rejecting the claims under § 103 over Enomoto, alone or in combination with additional prior art.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-5 under 35 U.S.C. § 102 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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STUART S. LEVY)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS
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) INTERFERENCES
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MAHSHID D. SAADAT)
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